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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/962,271 10/31/97 FREEMAN

G 04644/068001

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QM22/0730

EXAMINER

FOSTER, J

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 07/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/962,271

Applicant(s)
Freeman et al.

Examiner
Jimmy G. Foster

Art Unit
3728



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 6, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14, 18, 20-23, 26, 27, and 29-51 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 18, 20-23, 26, 27, and 29-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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1. Claims 1-12, 14, 18, 20-22 and 49-51 patentably distinguish over the prior art.

2. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed since specific amendments to the claims have been made which were not addressed by the declaration of April 6, 2000 or by the original declaration.

Claim 1-12, 14, 18, 20-23, 26, 27, 29-51 are therefore rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

3. Claims 23, 26, 27, and 29-48 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v.*

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Stein, Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. **See MPEP 1412.02.**

To attempt to achieve allowance on April 27, 1995, claim 15 of the original application, which became patent claim 16, was amended by Applicant to add, a limitation, "a releasable seal adapted to seal said compartment and maintain", with the term "maintain" referring to the already existent limitation, "...said electrode in a sealed mode". Applicant also added a limitation that a barrier element was positioned at the releasable seal. The claim had not previously included a limitation regarding a releasable seal. Reissue claims 23, 26, 27, and 29-48 are missing this limitation with respect to a releasable seal. The reissue claims 23, 26, 27, and 29-48 are also missing the limitation with respect to the barrier element being positioned at the releasable seal.

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Inasmuch as the limitations that are missing in claims 23, 26, 27, and 29-48 are ones Applicant had relied upon for allowance of said claim 15, it is asserted that Applicant is now trying to improperly recapture subject matter that Applicant had surrendered to achieve the allowance.

4. Claims 23, 26, 27, and 29-48 distinguish over the prior art. However, indication of patentable subject matter in these claims has been withheld in view of rejection under 35 U.S.C. 251 set forth in paragraph 3.

5. In Applicant's response filed on July 6, 2001, Applicant's argument that the narrowing of some limitations in claim 23 has negated recapture, is not persuasive.

Applicant has cited a passage from the decision, Hester Industries, Inc v. Stein, Inc. 142 F.2d 1427, 46 USPQ2d 1641 (Fed. Cir. 1998) as being:

[an applicant may] overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

Relying on this citation, Applicant has argued that the present amendments in claim 23 have made the claim *materially narrower* than the original claim 15 of the patent. Applicant therefore asserts that since claim 23 and its dependent claims are *materially narrower*, this is an exception of the type that was

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discussed by the court, and the rejection with respect to improper recapture should be withdrawn.

But on closer scrutiny of the entire discussion of the decision, Hester Industries, Inc v. Stein, Inc, it is clear that Applicant has seriously taken the above passage out of context.

The complete passage is:

In the context of a surrender by way of argument, this principle, in appropriate cases, may overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

(examiner's emphasis).

What this passage *really* refers to is the situation brought up in a preceding paragraph of the decision, located two paragraphs away. The court in that preceding paragraph discussed the surrender of subject matter by "argument alone". "Argument alone" means *not by amendment*.

Furthermore, upon a faithful reliance of the above decision, it is discovered that the court makes no exception for when the surrender of subject matter, which has been recaptured, has been made by amendment or cancellation. Any exception provided for occurs only when the surrender was made by argument.

The surrender of subject matter in Applicant's situation was a surrender made by amendment. Therefore, Applicant's recapture of surrendered subject matter will be granted no exception.

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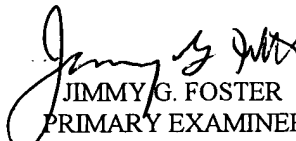
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GROUP 3720 7/26/01

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July 26, 2001